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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,703	02/05/2004	William M. Colone	297912002103	5606

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EXAMINER

AUGHENBAUGH, WALTER

ART UNIT PAPER NUMBER

1772

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/772,703

Applicant(s)

COLONE, WILLIAM M.

Examiner

Walter B. Aughenbaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-53 is/are rejected.
- 7) ☒ Claim(s) 53 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 5, 2006 (Amdt. B) has been entered.

Acknowledgement of Applicant's Amendments

2. The amendment made in claim 50 in the Amendment filed October 5, 2006 (Amdt. B) has been received and considered by Examiner.

WITHDRAWN OBJECTION

3. The objection to claim 50 made of record in paragraph 5 of the previous Office Action mailed February 9, 2006 has been withdrawn due to Applicant's amendment in claim 50 in Amdt. B.

REPEATED OBJECTIONS

Specification

4. The objection to the specification made of record in paragraph 4 of the previous Office Action mailed February 9, 2006 has been repeated for the reasons previously made of record:

Claim Objections

5. The objection to claim 53 made of record in paragraph 6 of the previous Office Action mailed February 9, 2006 has been repeated for the reasons previously made of record.

REPEATED REJECTIONS

Claim Rejections - 35 USC § 112

6. The 35 U.S.C. 112, first paragraph, rejection of claims 42 and 50 made of record in paragraph 8 of the previous Office Action mailed February 9, 2006 has been repeated for the reasons previously made of record.

7. The 35 U.S.C. 112, first paragraph, rejection of claims 42, 50, 52 and 53 made of record in paragraph 9 of the previous Office Action mailed February 9, 2006 has been repeated for the reasons previously made of record.

8. The 35 U.S.C. 112, second paragraph, rejection of claims 42, 50 and 53 made of record in paragraph 11 of the previous Office Action mailed February 9, 2006 has been repeated for the reasons previously made of record.

Claim Rejections - 35 USC § 102

9. The 35 U.S.C. 102 rejection of claims 42, 50, 52 and 53 made of record in paragraph 12 of the previous Office Action mailed February 9, 2006 has been repeated for the reasons previously made of record.

Claim Rejections - 35 USC § 103

10. The 35 U.S.C. 103 rejections of claims 43-49 and 51 made of record in paragraphs 13 and 14 of the previous Office Action mailed February 9, 2006 have been repeated for the reasons previously made of record.

Response to Arguments

11. Applicant's arguments presented on pages 4-6 of Amdt. B regarding the 35 U.S.C. 112, first paragraph, rejection of claims 42 and 50 made of record in paragraph 8 of the previous Office Action mailed February 9, 2006 have been fully considered but are not persuasive.

Applicant's interpretation of the rejection as "arguing... that the equations and definitions related thereto (i.e., radial expansion ratio) are indefinite or undefined" is incorrect: this rejection is a rejection under 35 U.S.C. 112, first paragraph (as opposed to a rejection under 35 U.S.C. 112, second paragraph, which pertains to indefiniteness). Applicant's statement that "... Pmax and Pburst must be approximately equivalent or equal in order for the value of RER to be 1.0" is correct, but this statement does not address the basis of the rejection, i.e. does not refute that claims 42 and 50 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. As discussed in paragraph 8 of the previous Office Action mailed February 9, 2006, the specification provides a definition for Pmax, and the pressure at burst is not disclosed in the definition as equivalent to Pmax, so Applicant's assignment of Pburst as equivalent to Pmax, which results in a RER of 1.0, was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's statement in the specification that "an RER of 1.0 is an ideal value" is not a statement that Applicant has achieved an RER of 1.0 where the Pmax used to calculate RER is the Pmax as Pmax is defined in the specification.

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Applicant's statement in lines 11-12 of page 6 of Amdt. B that refers to the three examples in the specification that report an RER of 1.0 does not show that Applicant's methodology in determining this RER value is described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s); at the time the application was filed, had possession of the claimed invention because the pressure at burst is not disclosed in the definition of Pmax provided in the specification as equivalent to Pmax in any scenario. As discussed above, the basis of this rejection is not that "the definition of radial expansion ratio is indefinite or undefined" as Applicant's characterize the basis of rejection.

12. Applicant's arguments presented on pages 6-7 of Amdt. B regarding the 35 U.S.C. 112, first paragraph, rejection of claims 42, 50, 52 and 53 made of record in paragraph 9 of the previous Office Action mailed February 9, 2006 have been fully considered but are not persuasive. Applicant's arguments here do not address the rejection of record, and Applicant has not explained how Applicant's arguments here address the rejection of record.

13. Applicant's arguments presented on page 7 of Amdt. B regarding the 35 U.S.C. 112, second paragraph, rejection of claims 42, 50 and 53 made of record in paragraph 11 of the previous Office Action mailed February 9, 2006 have been fully considered but are not persuasive.

Applicant's understanding of the basis of this rejection as articulated on page 8 of Amdt. B is substantially correct (more accurately, the position of the Office is that Pmax "cannot be determined on a balloon that has burst before reaching its Pmax" [paragraph 11 of the previous Office Action mailed February 9, 2006], according to the definition of Pmax as disclosed in the specification). Applicant's statement that "when the tube bursts, the structural integrity of the

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tube is lost, as one skilled in the art understands” is unsupported, and is also irrelevant since a specific characterization of “when [structural integrity] is lost” is provided in Applicant’s specification, and this specific characterization does not include burst.

In regard to Applicant’s arguments regarding the 35 U.S.C. 112, second paragraph, rejection of claim 53, Applicant states that “the ranges are provided for different elements, namely original inner diameter (claim 52) and dilated inner diameter (claim 53)”, but Applicant has not explained how the “original inner diameter” and the “dilated inner diameter” are “different elements”: both the “original inner diameter” and the “dilated inner diameter” are an “inner diameter” so it is not clear how these are “different elements”. If Applicant intends to argue that these are the inner diameter at different points in time (i.e. before pre-dilation and after pre-dilation), the only inner diameter that is relevant to the instant claims is the inner diameter of the claimed final product, equivalently, the “dilated inner diameter”. The inner diameter of the pre-dilated after dilation (as opposed to after pre-dilation but before dilation) is also not relevant because claims 52 and 53 recite a “product comprising a radially pre-dilated tube”. Since both claims recite an “inner diameter of the radially pre-dilated tube”, both claims recite the same diameter and the terms “original” and “dilated” afford no distinction in examining these article claims since the only inner diameter that is relevant to the instant claims is the inner diameter of the claimed final product.

14. Applicant’s arguments presented on page 8 of Amdt. B regarding the 35 U.S.C. 102 rejection have been fully considered but are not persuasive. Applicant’s arguments here depend entirely upon Applicant’s arguments regarding each of the rejections of claims 42 and 50 under 35 U.S.C. 112, first and second paragraphs, which have been addressed above.

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15. Applicant's arguments presented on page 9 of Amdt. B regarding the 35 U.S.C. 103 rejections have been fully considered but are not persuasive. Applicant's arguments here depend entirely upon Applicant's arguments regarding each of the rejections of claims 42 and 50 under 35 U.S.C. 112, first and second paragraphs, which have been addressed above.

Conclusion

16. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-

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1488. While the examiner sets his work schedule under the Increased Flexitime Policy, he can normally be reached on Monday-Friday from 8:45am to 5:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is to 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh
11/22/06

WBA


JENNIFER MCNEIL
SUPERVISORY PATENT EXAMINER
11/24/06